



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,798	01/22/2002	Harry L. Tarnoff	ZOUSA.001A3	7429

20995 7590 05/13/2004

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

WASSUM, LUKE S

ART UNIT PAPER NUMBER

2177

DATE MAILED: 05/13/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,798

Applicant(s)TARNOFF, HARRY L. **Examiner**

Luke S. Wassum

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6.7</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. The Applicant's claim to domestic priority under 35 U.S.C. § 119(e), based upon U.S. Provisional Application 60/263,148, filed 22 January 2001, is acknowledged.
2. Since the scope of the subject matter claimed in the instant application is greater than that disclosed in the provisional application, particularly with regard to the use of RevBots to provide digital rights management, the priority date will be either 22 January 2001 or 22 January 2002, depending upon the specific claim considered.

Information Disclosure Statement

3. The Applicants' Information Disclosure Statements, filed 11 September 2002 and 2 July 2002 respectively, have been received and entered into the record. Since the Information Disclosure Statements comply with the provisions of MPEP § 609, the references cited therein have been considered by the examiner. See attached forms PTO-1449.

Drawings

4. The Applicant's Formal Corrected Drawings, filed 19 June 2002, have been received and entered into the record. The drawings are approved.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Umbreit (U.S. Patent 6,704,787).

7. Regarding claim 1, Umbreit teaches a method of automatically modifying content transmitted over a network from a website to a requester client as claimed, comprising:

a) attaching a RevBot to a website, said RevBot

i) receiving from the website the content requested by said client (see col. 2, lines 37-39; see also col. 6, line 58 through col. 7, line 10);

ii) automatically determining the type of access to be provided to said client (see col. 2, lines 39-50; see also col. 6, line 58 through col. 7, line 10); and

iii) automatically modifying the content sent to the client (see col. 6, line 58 through col. 7, line 10).

8. Regarding claim 10, Umbreit teaches a method of enabling a search engine and other nodes to have access to restricted content of a network site as claimed, comprising:

a) attaching a RevBot to said site, said RevBot

Art Unit: 2177

- i) receiving from a network site the content requested by said search engine and other nodes (see col. 2, lines 37-39; see also col. 6, line 58 through col. 7, line 10);
- ii) automatically determining the type of access to restricted content to be provided to said search engine and other nodes (see col. 2, lines 39-50; see also col. 6, line 58 through col. 7, line 10); and
- iii) automatically transmitting the restricted content or subset or derivative thereof to said search engine and other nodes (see col. 6, line 58 through col. 7, line 10).

9. Regarding claim 15, Umbreit teaches a method of automatically modifying content transmitted over a network to a requester client as claimed, comprising:

- a) receiving from said network the content requested by said client (see col. 2, lines 37-39; see also col. 6, line 58 through col. 7, line 10);
- b) automatically determining the type of access to be provided to said client (see col. 2, lines 39-50; see also col. 6, line 58 through col. 7, line 10); and
- c) automatically modifying the content to be provided to the client (see col. 6, line 58 through col. 7, line 10).

10. Regarding claims 2 and 4, Umbreit additionally teaches a method wherein said RevBot automatically filters the content by deleting a portion of the content before it is provided to said client (see col. 6, line 58 through col. 7, line 10).

11. Regarding claim 3, Umbreit additionally teaches a method wherein said RevBot automatically enhances the content sent to said client (see col. 7, lines 25-26).

Art Unit: 2177

12. Regarding claims 5, 6, 11 and 12, Umbreit additionally teaches a method wherein said RevBot participates in an e-commerce transaction, for fee-based content access (see col. 6, line 58 through col. 7, line 10).

13. Regarding claims 7 and 13, Umbreit additionally teaches a method wherein said RevBot participates in a commerce transaction for supporting the physical distribution of goods and services (see col. 7, lines 23-24).

14. Regarding claims 8, 9 and 14, Umbreit additionally teaches a method wherein said RevBot provides digital rights management for protecting copyrighted material (see disclosure of access to entertainment content including textual, video and music content, such content constituting the claimed copyrighted material, copyrighted material including intellectual property, col. 7, lines 21-22).

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Win et al. (U.S. Patent 6,161,139) teaches a method that comprises storing information that defines administrative roles that govern access to administrative functions.

Win et al. (U.S. Patent 6,182,142) teaches a method for controlling access to information resources, wherein a single sign-on gives the user access to authorized resources based on the user's role in the organization.

Knight et al. (U.S. Patent 6,493,703) teaches an on-line message board system that monitors message traffic generated by subscribers so that intelligent decisions can be made concerning what types of content to locate and retrieve.

Knight (U.S. Patent 6,151,681) teaches a program for facilitating user interactions with an on-line message board system.

Knight et al. (U.S. Patent 6,571,234) teaches a system including a number of customized software robots for managing queries and postings made to an on-line electronic message board.

Stefik et al. (U.S. Patent 6,708,157) teaches a system for controlling the distribution and use of digital works using digital tickets.

Norris (U.S. Patent 6,718,328) teaches a system for controlling access to content on a network computer.

Knight et al. (U.S. Patent 6,721,748) teaches an intelligent data content provider system for subscriber postings and queries.

Richards et al. (U.S. Patent Application Publication 2002/0016922) teaches a persistent data control system for securely distributing data on a network by decoding a plurality of file control fields including fields for encoded use rights and/or access rights and rendering the decoded data in accordance with the decoded use and access rights.

Brown et al. (U.S. Patent Application Publication 2003/0050919) teaches a system for providing access rights information on a computer accessible content.

Safadi (U.S. Patent Application Publication 2003/0126086) teaches a method to allow content protected by different digital rights management schemes from a plurality of content providers to be downloaded, and played and/or viewed on a single consumer device.

Art Unit: 2177

Wang et al. ("XrML – Driving the Standard for Digital Rights Management") is a powerpoint presentation regarding digital rights management and the applications of the XrML standard to the problem.

Sanborn ("Protecting Intellectual Property on the Web") teaches digital rights management and content rights.

Knorr ("Content Rights and Wrongs") teaches the impact of the lack of standardization in digital rights management.

The following references, while not qualifying as prior art, are also of interest:

ContentGuard ("XrML 2.0 Technical Overview") gives an overview of version 2.0 of the XrML standard.

Wang et al. ("XrML – eXtensible rights Markup Language") teaches a brief introduction to XrML, its data model, usage and extensibility as it applies to digital media, multi-tier content distribution and XML-based healthcare.

MSN Encarta ("Definition of Intellectual Property") discloses that the concept of intellectual property encompasses copyrights.

Art Unit: 2177

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 703-305-5706. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 703-305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 703-746-5658.

Customer Service for Tech Center 2100 can be reached during regular business hours at (703) 306-5631, or fax (703) 746-7240.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Luke S. Wassum
Art Unit 2177

lsw

11 May 2004